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In re Application of	:	OFFICE OF PETITIONS
Hanna Albert Awad	:	
Application No. 09/886,862	:	DECISION DISMISSING
Filed: November 20, 2001	:	RENEWED PETITION UNDER
Title: CONCEPTS AND THEIR	:	37 C.F.R. §1.137(a)
APPLICATIONS, PUMPS, COMPRESSORS	:	
WORKING ON VALVES AND ENGINES	:	
WORKING ON THOSE COMPRESSORS	:	

This is a decision on the renewed petition filed May 19, 2005, pursuant to 37 C.F.R. §1.137(a)¹, to revive the above-identified application.

The above-identified application became abandoned for failure to file an appeal brief within two months of the submission of the Notice of Appeal. On September 24, 2002, a final Office action was mailed. On February 11, 2003, a Notice of Appeal was received, along with the fee associated with the filing of the Notice of Appeal and a two-month extension of time to make timely this response. No appeal brief was received. Pursuant to 37 C.F.R. §1.192², the failure to

1 A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:

- (1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
- (2) the petition fee;
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
- (4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

2 37 CFR 1.192. Appellant's brief.

- (a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.
- (b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

submit an appeal brief within two months from the date of the notice of appeal will result in the abandonment of the application. Accordingly, the above-identified application became abandoned on April 12, 2003. A Notice of Abandonment was mailed November 28, 2003.

The Changes of Correspondence Address, submitted on April 26, 2004 and May 3, 2004, were entered and made of record.

The original petition was submitted on November 1, 2004. On November 17, 2004, a one page statement of facts and an appeal brief were filed. The original petition was dismissed via the mailing of a decision on April 21, 2005, for failure to submit the petition fee.

With the instant petition, petitioner has included the petition fee, a submission which appears to be an appeal brief, and a statement of facts.

It is noted that Petitioner has written "I think I am not entitled to pay even the 250 \$ for petition. It must be a petition under 1.181 but Mr. Shanoski told me to pay 250 \$" on page 4 of the renewed petition. First, it is noted that both of the petitions Petitioner has filed were filed using the form for submitting a petition under 37 C.F.R. §1.137(a). Petitioner will note the heading **"PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)"** (emphasis included) which appears on each of his submissions. Nowhere in the original petition do the phrases "petition under 37 C.F.R. §1.181" or "petition to withdraw the holding of abandonment" appear.

Secondly, *assuming arguendo*, that the Office should have realized that it was Petitioner's intent to seek the withdrawal of the holding of abandonment, the petition submitted on November 1, 2004 was not timely filed. MPEP 711.03(c) sets forth that a petition to withdraw the holding of abandonment must be filed within two months of the mail date of the notice of abandonment³. Since the notice of abandonment was mailed on November 28, 2003, the submission of a petition to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181 was not possible after January 29, 2004 had passed.

The renewed petition under 37 C.F.R. §1.137(a) lacks items (1) and (3) above.

Regarding the first requirement, Petitioner has failed to submit the required response. Although he has submitted the petition fee along with what appears to be an appeal brief, Petitioner has not submitted the fee associated with the filing of a brief in support of an appeal, which is \$250 for a small entity.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical

³ See also 37 C.F.R. 1.181(f), which states, in part, "Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable."

statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."⁴

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense."⁵

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"⁶

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."⁷

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁸

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁹

Nonawareness of a PTO rule will not constitute unavoidable delay¹⁰

4 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

5 Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

6 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

7 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

8 Id.

9 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

10 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

The burden of showing the cause of the delay is on the person seeking to revive the application¹¹.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action¹².

The portion of the CFR and MPEP relevant to the abandonment of this application

37 C.F.R. § 1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

37 C.F.R. § 1.192 Appellant's brief.

- (a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.
- (b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

MPEP 1206, Appeal Brief, states, in part:

TIME FOR FILING APPEAL BRIEF

37 CFR 1.192(a) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief. In an ex parte reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274. The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512. However, 37 CFR 1.192(a) alternatively permits the brief to be filed "within the time allowed for reply to the action from which the appeal was taken, if such time is later." These time periods may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) is not available, under 37 CFR 1.136(b) for extraordinary circumstances.

In the event that the appellant finds that he or she is unable to file a brief within the time period allotted by the rules, he or she may file a petition, with fee, to the Technology Center (TC), requesting additional time under 37 CFR 1.136(a). Additional time in excess of 5 months will not be granted unless extraordinary circumstances are involved

¹¹ Id.

¹² See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

under 37 CFR 1.136(b). The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

...

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See MPEP § 1215.04. **If there are no allowed claims, the application is abandoned as of the date the brief was due.** Claims which have been objected to as dependent from a rejected claim do not stand allowed. In a reexamination proceeding failure to file the brief will result in the issuance of the certificate under 37 CFR 1.570.

If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application, as in other cases of abandonment, and to reinstate the appeal; if the appeal is dismissed, but the application is not abandoned, the petition would be to reinstate the claims and the appeal, but a showing equivalent to that in a petition to revive under 37 CFR 1.137 is required. In either event, a proper brief must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be in error, filing a petition, pointing out the error, may be sufficient.

A fee under 37 CFR 1.17(c) is required when the brief is filed. 37 CFR 1.192(a) requires the submission of three copies of the appeal brief.

(Emphasis added)

Application of the standard to the current facts and circumstances

As indicated in the Final Rejection, mailed on September 24, 2002, claims 1-2 were pending, and claims 1-2 were rejected. No claims were indicated as being allowed. As such, pursuant to 37 C.F.R. §1.192 and MPEP 1206 reproduced above in part, the application became abandoned on April 12, 2003. In both the original and the renewed petitions, Petitioner has alleged that he sent numerous requests to have his correspondence address changed, and that he wished to “continue the patent even with an appeal¹³.” Twenty-one months passed between the filing of the notice of appeal and the submission of the appeal brief. It is not clear how the mailing of a plurality of requests to have his address changed prevented the Petitioner from filing his appeal brief until this time.

With the renewed petition, Petitioner has asserted that a representative with the Patent Assistance center informed him that an appeal brief did not need to be submitted “because they have all the application¹⁴.” It is not clear when Petitioner alleges this conversation to have taken place – was it before or after his submission of the appeal brief on November 17, 2004? Perhaps the discussion allegedly took place after the submission of the appeal brief, and Petitioner is attempting to convey the message that a duplicate copy of the appeal brief was deemed not to have been necessary because a copy was already received on November 17, 2004? Conversely, if Petitioner is alleging that the conversation took place prior to his submission of the appeal brief, and that he was instructed not to file an appeal brief, Petitioner is reminded that a delay that has been caused by an applicant’s reliance upon oral advice from USPTO employees is not

¹³ Original petition, page 6.

¹⁴ Renewed petition, page 3.

unavoidable¹⁵. Furthermore, as set forth in 37 C.F.R. §1.2, no attention will be paid to any alleged oral understanding in relation to which there is disagreement or doubt.

In conclusion, it is not clear what prevented Petitioner from submitting the appeal brief in a timely manner. Petitioner has not established that the entire period of delay was unavoidable. Therefore, this renewed petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Second Renewed Petition under 37 C.F.R. §1.137(a)."

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski.

Any renewed petition may be submitted by mail¹⁶, hand-delivery¹⁷, or facsimile¹⁸.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.

Alternate venue

Petitioner may also wish to consider filing a petition under the unintentional standard, 37 CFR §1.137(b)¹⁹. Petitioner should be made aware that although the surcharge is significantly higher (\$750 for a small entity), the standard associated with a petition filed under this section is far less stringent than the standard associated with a delay asserted to be "unavoidable". A form for this petition may be located at <http://www.uspto.gov/web/forms/sb0064.pdf>



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

¹⁵ *In re Sivertz, supra*.

¹⁶ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

¹⁷ Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

¹⁸ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.

¹⁹ A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.